

REMARKS

The Examiner's attention to the present application is noted with appreciation.

In paragraph 1 of the Office Action dated April 27, 2004, the Examiner states that on page 9, lines 12-13, the original filed specification supports the metal deactivator preferably comprising between 0.05 and approximately 0.15 parts by weight, and most preferably approximately 0.01 parts by weight. In the prior response to the Office Action dated March 31, 2003, Applicant was attempting to amend the specification to return to the original specification language. In the amendments to the specification in this response amended claim 92 and new claim 171, that language has been corrected. Applicant also found an error on page 8 line 21 and the language has been amended in this response to return to the originally filed specification. New claim 171 does not present any additional material, but was merely added to clarify the claims to match the original language.

In paragraph 3 of the Office Action, the Examiner rejected claims 162 through 170 under 35 U.S.C. §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner disagrees that the specification supports non-platinum as an alternative embodiment. The Examiner states that because non-platinum is not limited to those elements recited in the specification, the listed compounds do not comprise an exhaustive list of non-platinum compounds. Claim 162 has been amended to recite "an organo-metallic compound other than a platinum compound" to particularly point out that this claimed fuel composition (claim 162) is one alternative embodiment as described in the specification that contains an organo-metallic compound that does not contain platinum (also note dependent claim 165 which then adds the platinum compound to such composition as another embodiment). The specification supports the, "other than a platinum compound" language in the bridging paragraph on pages 6-7 lines 1-2 which read

“The organometallic compound utilized is preferably iron. Manganese, platinum and cerium may also be utilized separately, mixed or mixed with iron.”

These alternative embodiments of the fuel composition that comprise “other than a platinum compound” are thus clearly supported and do not require an exhaustive list of non-platinum compounds to be identified within the specification. Therefore, we believe this claim is in a condition for allowance.

The Manual of Patent Examining Procedure, 8th Ed., §2173.05(i) reads “The current view of the courts is that there is nothing inherently ambiguous or uncertain about negative limitation. So long as the boundaries of the patent protection sought are set forth definitely, albeit negative, the claim complies with the requirements of 35 U.S.C. §112, second paragraph.” The courts at first were against negative limitations, see *In re Schechter*, 205 F.2d 185, (C.C.P.A. 1953), because of undue breadth or obviousness. However, the courts moved away from that view in subsequent cases when there was at least some definition of what the negative claim was claiming. In *In re Bankowski*, involving a number of claims for making chicken vaccine against Newcastle disease, the court held that the “devoid of avian tissue” did not render the claims indefinite. *In re Bankowski*, 318 F.2d 778, 784 (C.C.P.A. 1963). Similarly in *In re Duva*, 387 F.2d 402 (C.C.P.A. 1967), which included a negative limitation reading “absent sufficient CN ions”, the court reversed rejection of the claims, holding “It is also significant, we think, that the prior art reference proposes to electroplate an alloy of gold and palladium by use of a palladium anode in the electrolyte and the establishment of a potential of a stated magnitude between the anode and the cathode. Appellant deposits gold, not an alloy of gold and palladium as the prior art teaches.” *Id.* at 407. The court continues in this vein allowing negative limitations to help define the claims over the prior art, as long as the negative limitation or exclusionary proviso has basis in the original disclosure. *Ex Parte Grasselli*, 738 F.2d 453, (Fed. Cir. 1984) (mere absence of a positive recitation is not basis for an exclusion); *In re Johnson*, 558 F.2d 1008, 1019 (if the specification describes the whole, then it describes the remaining

part); *In re Wakefield*, 422 F.2d 897, 899 (C.C.P.A. 1970) (the claim reciting the limitation in order to exclude the prior art was considered definite...); MPEP, 8th Ed., §2173.05(i); Chisum on Patents, §8.06, ©2004, Matthew Bender & Co., Inc. Finally, in an unpublished opinion from the Board of Patent Appeals and Interferences, the board reversed the § 103 rejections for obviousness because the negative limitation resulted in a different compound, not obvious to one skilled in the art, which “did not teach or suggest the claimed increase in the combined yield of gasoline/light cycle oil and we can not predict from their disclosure that this will occur.” *Ex Parte Senn*, 1996 WL, 1800557 para. 5.

Because the original specification clearly states that the compound is an organometallic compound, other than a platinum compound, it is distinguished from *Schechter*, and falls well within the current view of what a negative limitation in a claim defines. The claim is not speaking of all non-platinum compounds, only those organometallic compounds that do not contain platinum. Therefore, we believe claim 162 in condition for allowance.

Claims 163 through 170 are dependent on claim 162. Accordingly, we believe these claims to also be in a condition for allowance.

In paragraphs 5 and 6 of the Office Action, the Examiner rejected claims 67 through 170 under 35 U.S.C. §112 as failing to comply with the written description requirement. The Examiner stated that there is no support in the specification for less than approximately 0.005 parts by weight of said organometallic compound and that the claim as written has no lower limit for the amount of the compound that may be present in the composition. Claim 67 has been amended to recite “an iron-containing organometallic compound comprising between approximately 0.0001 and approximately 0.005 parts by weight of said organometallic compound in said fuel additive...” The claim as amended is supported in the specification on page 7 beginning at line 5.

In paragraphs 7 and 8 of the Office Action, the Examiner rejected claims 67 through 170 under 35 U.S.C. §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention. The Examiner rejected claim 67 because there was no identified lower limit for the amount of iron-containing organometallic compound present in the composition. Claim 73, 81 and 95 were rejected for recitation of the trademarks Primene®RB-3, Conosolve®C-145, and Vancide® respectively. Claim 162 was rejected for use of the language "between less than". Each of these rejections are discussed below.

As stated above, claim 67 now includes a lower limit for the iron-containing organometallic compound of 0.0001 parts by weight. This amount is supported in the original specification language on page 7 beginning at line 5.

The use of a trademark is acceptable (MPEP §6-8.01(v)) when the product the trademark refers to is set forth in such language that its identity is clear. However, claim 73 has been amended to read "said high molecular weight amine comprises a t-alkyl primary amine fuel additive", and it is supported in the specification as such on page 6 line 14. Claim 81 has been amended to read "naphtha comprises an aliphatic solvent", and is supported in the specification on page 7 lines 26-27. Claim 95 has been amended to read "triazine comprises hexahydro-1,3,5-triethyl-s-triazine", and is supported in the specification on page 8 lines 27-28.

In claim 162 the word "between" has been deleted.

In view of the above amendments and remarks, it is respectfully submitted that all grounds of rejection and objection have been avoided and/or traversed. It is believed that the case is now in condition for allowance and same is respectfully requested.

If any issues remain, or if the Examiner believes that prosecution of this application might be expedited by discussion of the issues, the Examiner is cordially invited to telephone the undersigned attorney for Applicant at the telephone number listed below. A check for additional claim fees is attached.

Authorization is given to charge payment of any additional fees required, or credit any overpayment, to
Deposit Acct. 13-4213.

Respectfully submitted,

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